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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,190	06/12/2001	Dan Kalas	81206-243306	5821

7590 12/20/2002

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EXAMINER

GURZO, PAUL M

ART UNIT

PAPER NUMBER

2881

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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DEC 27 2002

CL# 081206 MT# 0243306

ATTY(S) NASI-ESC

DUE: MARCH 20, 2003 (3 MOS) - JUNE 20, 2003 (6 MOS.)

DKT BY (1) MSG (2)

Office Action Summary

Application N

09/880,190

Applicant(s)

KALAS ET AL.

Examiner

Paul Gurzo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to a radiation source, classified in class 250, subclass 493.1.
- II. Claims 19-33, drawn to a method of making a radiation source, classified in class 427, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of a radiation source can be made by a different method such as the method taught by Peterson et al. (WO 01/84560). Their method of making a radiation source does not include the step of opening an outer housing having a fastener.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Roger Wise on December 10, 2002, a provisional election was made without traverse to prosecute the invention of a radiation source, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" does not appropriately define the claimed relationship. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carden Jr. et al. (6,086,942 - hereinafter '942), and further in view of Martin (4,676,193 - hereinafter '193). '942 teaches a radiation source comprising an outer housing, a substrate that has a front surface and is contained within the housing, and a radioactive deposit that has a radioisotope and is fixedly deposited upon the surface (col. 2, lines 42-45 and col. 3, lines 1-3 and lines 39-41). They do not mention use of a fastener attached to the outer housing. However, '193 teaches a substrate holding means that make use of fasteners (col. 15, line 64 - col. 16, line 11). It is inherent that the use of screws makes this housing configured to be opened. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing to be made to open so that proper handling and substrate selection will occur.

Claims 2-11 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over C '942), in view of '193, and further in view of Peterson et al. (WO 01/84560 - hereinafter '560).

Regarding claims 2-4 and 7, while the above applied art teaches the use of a substrate, they are silent to the claimed makeup. However, '560 teaches that the substrate can be made

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from any suitable material (i.e. flexible and radiopaque), including paper and plastic (page 6, lines 4-6). Having a first and second form factor is obvious to a substrate that is made of a flexible material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the substrate of the a flexible material because it is well known in the art that flexibility will increase the ease of handling and it is known that plastic is a flexible material.

Regarding claims 5 and 6, '560 teaches the claimed two layers and it is an obvious matter of design choice to have the activity density of each layer substantially the same (page 9, lines 28-30).

Regarding claims 8 and 9, '560 teaches the use of a colorant that corresponds to the activity of the radioactive deposit (page 7, lines 4-12).

Regarding claims 10 and 11, '560 teaches that claimed sealing layer (page 10, lines 2-5), and it is obvious that a binding agent exists to ensure proper sealing.

Regarding claims 14-16, the addition of a second substrate is inherent to the teachings of the prior art and it is obvious to produce a desired radioactive deposit. Further, '560 teaches the uniform activity distribution (page 9, line 16).

Regarding claims 17 and 18, the above-applied prior art teaches an outer housing configured to be opened, a flexible substrate contained within the housing that has a front surface, a radioactive deposit that has a radioisotope, binding agent, and colorant that is fixedly deposited upon the front surface, a portion of the deposit having two layers - each with substantially the same activity density, and the color of the deposit indicating the activity level of the deposit.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Gurzo whose telephone number is (703) 306-0532. The examiner can normally be reached on M-Thurs. 7:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Lee can be reached on (703) 308-4116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

PMG
December 13, 2002


JOHN R. LEE
SUPERVISORY PATENT EXAMINER
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